

U.S. Serial No. 09/761,203
Response to the Office action of August 17, 2005

Remarks

Claims 1-33 are pending and at issue in the above identified patent application. Of the claims at issue, claims 1, 27, and 32 are independent. In view of the foregoing amendments and the following remarks, reconsideration of the application is respectfully requested.

The Rejections Under 35 U.S.C. §§ 102 & 103

Claims 1-8, 17-20, 23-25, 27-33 were rejected as anticipated by, or unpatentable over, Kikuchi (US 6,577,811). Additionally, claims 9-12 were rejected as unpatentable over Kikuchi in view of Parasnis (US 6,728,753), claims 13-16 were rejected as unpatentable over Kikuchi in view of Fukushima and further in view of Paulus (US 6,678,757), and claims 21 and 26 were rejected as unpatentable over Kikuchi in view of Fukushima. It is respectfully submitted that claims 1-33 are allowable over the cited portions of there references for the reasons set forth below.

Claims 1-26 and 32-33

Independent claims 1 and 32 have been amended to include recitations similar to originally presented in claim 9. These claims now recite, *inter alia*, a memory for storing a plurality of selectable status parameters indicating functionality of the digital video recording device, wherein one of said plurality of selectable status parameters is a current delay feature which displays how far a recording is behind a live broadcast when a signal corresponding to the live broadcast is paused. As detailed below, neither Kikuchi nor Parasnis discloses or suggests such a recitation.

Kikuchi is directed to a recorded content protection scheme for a digital recording/reproducing system. In particular, Kikuchi discloses various aspects of a system used to record television or other programming onto an optical medium. The Office action concedes that Kikuchi fails to disclose how far a recording is behind a live broadcast when a signal corresponding to the live broadcast is paused. The Office action asserts that Kikuchi discloses that when a recording signal is suspended, the recording TV broadcast signal will be extended, citing col. 52, line 42 – col. 53, line 3. The cited portion of Kikuchi discloses that a temporal storage is used as a buffer to store program content during changes of the disk on which the recording is being stored. Further, the cited portion of Kikuchi indicates that

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the temporal storage may store 20 seconds of programming, which leaves a user 20 seconds to change the optical storage media. Kikuchi does not disclose or suggest that the Kikuchi system could or should display how far a recording is behind a live broadcast when the live broadcast is paused.

"To establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2143. To cure the deficiencies of Kikuchi, the Office action turns to Parasnis, citing col. 26, lines 57-66 and FIG. 18. Parasnis is directed to a system for broadcasting presentations over a network. Parasnis includes disclosure related to submitting events to be broadcast over a network.

The Office action cites col. 26, lines 57-66, of Parasnis for disclosure to cure the admitted deficiencies of Kikuchi. That is, disclosure related to the launching a text message when a signal is paused. However, the cited portion of Parasnis discloses a technique by which audience members may post messages that may be read by other audience members. FIG. 13 refers to pausing an ASF stream, but the flow diagram in which this information is found is related to preparing a presentation for broadcast. Thus, the pausing indicated at block 1260 of FIG. 13 is to "prevent the start of the presentation slideshow from being triggered." Parasnis, col. 22, line 48-58. Likewise, FIG. 17 shows a message that a presentation is about to begin in the next five minutes. However, none of this disclosure stands for the proposition of pausing a live broadcast that is in progress. In fact, the pausing in Parasnis is carried out prior to broadcast and, therefore, stops the broadcast from beginning. Thus, in the cited portions of Parasnis, there is no disclosure of pausing a live broadcast that is already in progress. Because the broadcast of Parasnis has not yet begun, there can be no indication of how far recording is behind a live broadcast.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a *prima facie* case of obviousness. See *In re Oetiker*, 24 USPQ. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 USPQ. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143.

With regard to motivation to make the proposed combination, Parasnis is not in the same field of endeavor as Kikuchi. While Kikuchi is directed to recorded content protection

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and storing programming to optical media, Parasnis is directed to a system for broadcasting presentations over a network. It is respectfully submitted that these two disclosures are not in the same field of endeavor, as one is directed to content storage and the other is directed to network communications and systems used to facilitate the distribution of presentations over the Internet. Furthermore, there is no motivation for the combination of Kikuchi and Parasnis. While the Office action states that it would have been obvious to modify Kikuchi by displaying a delay feature to read the recorded signal at any point, it is respectfully submitted that this motivation is flawed. This is at least in part because Kikuchi buffers programming long enough to facilitate a media change (e.g., 20 seconds). While a user is performing a media change, the user is not concerned with how far behind the live broadcast the recording is proceeding. Instead, the user seeks to change the media of Kikuchi as fast as possible to minimize the possibility of a buffer overflow and its attendant loss of programming content.

As illustrated above, both Kikuchi and Parasnis are deficient because they fail individually, and in combination, to disclose a system in which it is even possible to pause a live broadcast already in progress and provide a display indicating how far recording is behind the live broadcast already in progress. Thus, these references alone fail to anticipate claims 1 and 32. Furthermore, as explained above, there is no motivation for the modification that is proposed in the Office action. Thus, these references fail to render obvious claims 1 and 32. It is respectfully submitted that claims 1 and 32, and all claims dependent thereon, are in condition for allowance.

Claims 27-31

Claim 27 has been amended to include recitations from original claim 11. In particular, claim 27 recites, *inter alia*, storing a plurality of selectable status parameters indicating functionality of the digital video recording device within a memory of the digital video recording device, wherein one of said plurality of selectable status parameters is a live/recorded status feature that displays whether a program being viewed is either live or recorded.

The Office action concedes that Kikuchi does not disclose a live/recorded status feature that displays whether a program being viewed is live or recorded. To cure this

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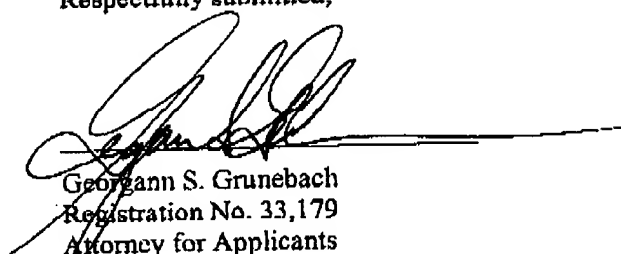
deficiency, the Office action relies on Parasnis. As noted above, Parasnis includes an event submission feature that enables a user desiring to broadcast an event to submit a form indicating the parameters of the event to be broadcast. Part of this submission is an indication of whether the content is live, on-demand, or live with slides. See Parasnis, FIG. 8. While the Office action contends that this disclosure displays whether a program is live or recorded, it is respectfully submitted that the context in which the information is provided, i.e., in the event submission form, occurs off-line. That is, the event submission form is completed before the program is being viewed. Thus, Parasnis does not disclose that such information is visible when the program is being viewed.

Because both Kikuchi and Parasnis fail to disclose display of a live/recorded status feature during program viewing, it follows that no combination of these references can result in system performing such functions. Thus, it is respectfully submitted that claims 27-31 are patentable over the combination of Kikuchi and Parasnis, even if there is a motivation for their combination, which is not conceded.

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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The DIRECTV Group, Inc.
RE / R11 / A109
P.O. Box 956
2250 E. Imperial Highway
El Segundo, CA 90245
310-964-4615



Georgann S. Grunebach
Registration No. 33,179
Attorney for Applicants